

REMARKS

Claims 371-483 are pending in the application.

Office Action of December 3, 2003

In an Office Action on December 3, 2003, the Office rejected claims 371-483 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,070,150 to Remington et al. ("the Remington patent") in view of Electronic Funds Transfer Project, Final Report, Washington State, October 1994. In a Reply on June 2, 2004, Applicant traversed each of these rejections. In the June 2, 2004 Reply, Applicant argued that the Remington patent cannot render any of the present claims obvious, alone or in combination, at least because the Remington patent does not qualify as prior art to the present application. In support of this contention, Applicant submitted three declarations: (1) a Declaration under 37 C.F.R. § 1.131 executed by Mr. John Polk ("the initial Polk declaration"), the named inventor of the claimed subject matter; (2) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Richard Vesper; and (3) a Declaration under 37 C.F.R. § 1.131, executed by Mr. Lionel M. Lavenue.

Applicant argued that these three declarations established that conception of the claimed invention occurred prior to October 18, 1996, the filing date of the Remington patent. In addition, Applicant argued that the declarations established that reasonable diligence was exercised by the inventor and the attorneys preparing the application from a date prior to October 18, 1996 through September 30, 1997, the filing date of U.S. patent application No. 08/941,187, the great-grandparent of the present application ("the '187 application"). The present application is a continuation of U.S. Patent Application No. 09/413,862, filed October 7, 1999, which is a continuation of 09/003,941, filed

January 7, 1998, now U.S. Patent No. 6,119,107, which is a divisional of the '187 application, now U.S. Patent No. 5,946,669.

Final Office Action of November 3, 2004

In the present Office Action, dated November 3, 2004, the Examiner stated that "[t]he Declaration filed on June 02, 2004 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the Remington et al (6,070,150) reference."¹ Office Action, p. 2. The Examiner further alleged that: "The exhibits filed failed to establish the conception of the claimed subject matter in the . . . application." Id. In particular, the Examiner alleged that the exhibits to the initial Polk declaration failed to teach three "items set forth in claims 371-481,"² namely:

1. Payment information including a debit transaction.
2. Transmitting the payment information from the accumulator agency to a bank.
3. Transmitting the disbursement information from the accumulator agency to an intermediary.

Id.

Respectfully, Applicant disagrees with the Examiner's conclusion.

¹ Although three declarations were filed in the preceding Reply, Applicant understands the Examiner's reference to "the Declaration" as a reference to the initial Polk declaration.

² Applicant notes that claims 371-483 are pending and understands the omission of claims 482-483 to be a clerical or typographical error in the Final Office Action.

With regard to some of the claims, the three features cited by the Examiner are simply not present in any form. For example, pending independent claim 405 recites:

A method of processing a child support disbursement,
comprising the steps, performed by a processor, of:

receiving at an accumulator agency child support
disbursement transaction information from a state regarding
the child support disbursement as an addendum transaction;
and

executing the child support disbursement to a recipient.

As seen in claim 405, the three features cited by the Examiner are entirely absent. Indeed, because some of the pending claims do not recite the features cited by the Examiner, the conception of these features is irrelevant to the patentability of those pending claims. Thus, the Examiner's rejections on these grounds are improper.

With regard to the remaining claims within the set of pending claims 371-483, Applicant is uncertain how to respond to the Examiner's conclusory and unexplained rejection of those claims. For example, pending independent claim 371 recites a method including processing from the agency to a bank the child support payment as a debit transaction and processing from the agency to an intermediary the child support disbursement information as an addendum transaction. Although the Examiner does not directly refer to either of these claim limitations in the Office Action (or indeed to any of the claim limitations), he does allege that the initial Polk declaration and exhibits failed to establish conception of payment information including a debit transaction and transmitting payment information from an accumulator agency to a bank and transmitting disbursement information from the accumulator agency to an intermediary.

However, the language in the Examiner's Office Action is different from the language recited in the claims. The Examiner refers to "payment information including a debit transaction" and "transmitting payment information from an accumulator agency to a bank," but the pending claim language is directed specifically to processing a child support payment to a bank (not generally to payment information) and is directed specifically to processing the child support payment as a debit transaction (not generally to information including a debit transaction). Further, the Examiner refers to "transmitting disbursement information from the accumulator agency to an intermediary," but the pending claim language is directed specifically to "processing from the agency to an intermediary the child support disbursement information as an addendum transaction." In Applicant's view, these are different (at least with respect to the distinction between a payment and a type of payment, i.e., a child support payment). Thus, the Examiner's position regarding conception of items (1), (2), and (3) are distinguishable from the claimed features, and the Examiner's rejections are incorrect.

Accordingly, because the Examiner's rejections of pending claims 371-483 are based on either improper rejections (i.e., that do not mention the claim elements) or incorrect (i.e., that are based on features different from those recited in the claims), Applicant requests that the Examiner kindly reconsider his position and allow the claims.

Furthermore, it is possible that the Examiner meant that if the initial Polk declaration and exhibits failed to establish conception of (1) payment information including a debit transaction, (2) transmitting payment information from an accumulator agency to a bank, and (3) transmitting disbursement information from the accumulator agency to an intermediary, then they also failed to establish conception of a method

including processing from the agency to a bank the child support payment as a debit transaction and processing from the agency to an intermediary the child support disbursement information as an addendum transaction.³ Based on such a possibility, and in order to fully respond to the Office Action, Applicant now addresses the conception of (1) payment information including a debit transaction; (2) transmitting payment information from an accumulator agency to a bank; and (3) transmitting disbursement information from an accumulator agency to an intermediary, although it is unclear how any of these features is recited in the pending claims.

Supplemental Polk Declaration

Applicant files herewith a Supplemental Declaration of John Polk under 37 C.F.R. § 1.131 ("the supplemental Polk declaration"), executed by Mr. Polk. Attached to the supplemental Polk declaration are two exhibits, Exhibit 1, entitled "Exhibit 1 The Problem Defined," and Exhibit 2, entitled "Exhibit 1 Electronic Processing of Wage Assignments."⁴ Together with the knowledge of one skilled in the art at the time of the invention, these documents evidence conception of at least the three items listed by the Examiner, specifically including (1) payment information including a debit transaction, (2) transmitting payment information from an accumulator agency to a bank, and (3)

³ If the Examiner intended to make a different argument in rejecting claims 371-483, Applicant respectfully requests that the Examiner set forth that argument and withdraw the finality of the Office Action in order to afford Applicant the opportunity to fully respond to the intended claim rejections.

⁴ The Examiner correctly recognizes: "It should be noted that both pieces of documentary evidence are listed as 'Exhibit 1.'" Indeed, both of the original documents were identified as "Exhibit 1" when they were created by Mr. Polk prior to October 18, 1996. For ease of reference, we refer to the first exhibit as "Exhibit 1" and to the second exhibit as "Exhibit 2" herein, as indicated by the cover sheets preceding the exhibits.

transmitting disbursement information from the accumulator agency to an intermediary.

See Suppl. Polk Decl. ¶¶ 6-9.

The Examiner contends that the initial Polk declaration failed to teach: (1) payment information including a debit transaction. However, as shown in the supplemental Polk declaration, Exhibit 2 teaches this item. Suppl. Polk Decl. ¶ 7. Mr. Polk explains as follows: “The reference to use of the ‘Formatted 521 Records’ by the accumulator agency clearly demonstrates two things: (1) use of a debit transaction (not a credit transaction) and (2) processing of the debit transaction to a bank.” Suppl. Polk Decl. ¶ 8. Mr. Polk further explains: “Therefore, the reference in Exhibit 2 to ‘the accumulator/router function permits the receipt and routing of electronic payment transactions from employers’ via ‘Formatted 521 Records’ clearly indicates a debit transaction, which is processed by the accumulator agency. (Emphasis added.)” Id. Thus, the supplemental Polk declaration clearly shows that the exhibits at issue establish the conception of payment information including a debit transaction.

The Examiner contends that the initial Polk declaration failed to teach: (2) transmitting payment information from an accumulator agency to a bank. However, as shown in the supplemental Polk declaration, Exhibits 1 and 2 teach this item from the claims. Suppl. Polk Decl. ¶ 9. Mr. Polk explains as follows: “Exhibits 1 and 2 also describe transmitting payment information from an accumulator agency to a bank due to the reference to ‘the accumulator/router function permits the receipt and routing of electronic payment transactions from employers . . . [via] Formatted 521 Records.’” Mr. Polk further explains: “One of ordinary skill in the art would have known that that ‘Formatted 521 Records’ always require a bank for processing; in fact, a debit

transaction requires two banks (the bank for the originator and the bank for the debtor)."

Id. Mr. Polk still further explains: "In order for the accumulator agency depicted in Exhibit 2 to 'route' electronic payments (e.g., to process payment information) in this 'closed loop operation,' the payments must be sent to a bank." Suppl. Polk Decl. ¶ 10.

Thus, the supplemental Polk declaration clearly shows that the exhibits at issue establish the conception of transmitting payment information from an accumulator agency to a bank.

The Examiner contends that the initial Polk declaration failed to teach: (3) transmitting disbursement information from the accumulator agency to an intermediary. However, as shown in the supplemental Polk declaration, Exhibits 1 and 2 teach this item. Suppl. Polk Decl. ¶ 11. Mr. Polk explains as follows: "Thus, Exhibit 1 clearly depicts the transmission of wage assignments from employers to a designated state (i.e., the 'state child support agency' depicted in Exhibit 1, and e.g., 'the intermediary' of claims 145-252)." Id. Mr. Polk further explains: "As shown in Exhibit 2, the solution offered by the accumulator agency was to separate the wage assignment orders into two parts, the record (e.g., 'the disbursement information' of claims 145-252) and the electronic payment (e.g., the 'payment information' of claims 145-252)." Id. Mr. Polk still further explains: "In this closed loop operation, the accumulator also processes disbursement information to the intermediary designated in the wage assignment order. On review of Exhibits 1 and 2, one of ordinary skill in the art would readily understand both of these processes performed by the accumulator agency, specifically including transmitting disbursement information from the accumulator agency to an intermediary." Id. Thus, the supplemental Polk declaration clearly shows that the exhibits at issue

establish the conception of transmitting disbursement information from the accumulator agency to an intermediary.

As demonstrated by the supplemental Polk declaration, the exhibits at issue (i.e., Exhibits 1 and 2) established the conception of (1) payment information including a debit transaction, (2) transmitting payment information from an accumulator agency to a bank, and (3) transmitting disbursement information from the accumulator agency to an intermediary.

Conclusion

For the reasons stated above, the Examiner's rejections of claims 371-483 are either improper (i.e., as not mentioning the claim elements) or incorrect (i.e., as based on features different from those actually recited in the claims). Accordingly, Applicant requests that the Examiner withdraw the rejections and allow the pending claims.

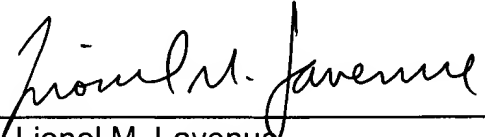
Additionally, although Applicant is uncertain exactly how the Examiner meant to relate the three recited items listed in the Final Office Action to the language of claims 371-483, the supplemental Polk declaration and accompanying exhibits, in combination with the declarations and exhibits filed with the June 2, 2004 Reply to Office Action, also establish conception of the three items prior to the filing date of the Remington patent. Therefore, the Remington patent is not a prior art reference even if any of the listed items is present in claims 371-483. Accordingly, for these reasons as well, all the rejections of claims 371-483 should be withdrawn with respect to the Remington patent.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 3, 2005

By: 
Lionel M. Lavenue
Reg. No. 46,859

Attachment: Supplemental Declaration of John Polk under 37 C.F.R. § 1.131
with Exhibits 1-2